

REMARKS

Applicants submit this Amendment in response to the Final Office Action mailed on October 23, 2009. Prior to this Amendment, claims 35-95 were pending in this application, of which claims 35, 53, 71 and 85 are independent. By this response, Applicants propose amending claims 35, 53, 71 and 85. No new matter would be added.

In the Office Action, the Examiner rejected claims 35-53 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Pat. Pub. No. 53080602 ("Fukuda") in view of Japanese Pat. Pub. No. 2249707 ("Ohashi"); rejected claims 53-68 under § 103(a) as being unpatentable over Fukuda in view of Ohashi and further in view of U.S. Pat. No. 6,635,132 ("Caretta"); rejected claims 71-84 under § 103(a) as being unpatentable over Fukuda in view of Ohashi and further in view of EP 847,800 ("Matsuo") and/or JP 2000-118212 ("Tsuboi"); and rejected claims 85-95 under § 103(a) as being unpatentable over Fukuda in view of Ohashi, Matsuo, and Tsuboi and further in view of Caretta.

Applicants respectfully traverse all pending rejections for at least the reasons discussed below.

Rejections Under 35 U.S.C. § 103(a)

Applying 35 U.S.C. § 103(a), the Examiner rejected claims 35-53 as being unpatentable over Fukuda in view of Ohashi, rejected claims 53-68 as being unpatentable over Fukuda in view of Ohashi and further in view of Caretta, rejected claims 71-84 as being unpatentable over Fukuda in view of Ohashi and further in view of Matsuo and/or Tsuboi, and rejected claims 85-95 over Fukuda in view of Ohashi,

Matsuo, and Tsuboi and further in view of Caretta. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, none of Fukuda, Ohashi, Caretta, Matsuo, or Tsuboi, alone or in any combination, teaches or suggests every feature of Applicants' claims. Specifically, none of the references cited by the Examiner teaches or suggests "wherein the modulus of elasticity under compression at 23°C of said first elastomeric material is 20 to 80 MPa," as recited in independent claim 35. Similar features are recited in independent claims 53, 71, and 85.

With respect to the claimed values of the modulus of elasticity, Fukuda and Ohashi not only fail to disclose values of this parameter that are comparable with those claimed, but actually teach away from Applicants' claims and would lead a person skilled in the art away from the present invention.

In fact, Ohashi expressly advises against using a rubber composition for the peripheral portion of the blocks or ribs formed in the tread band having a dynamic modulus of elasticity exceeding 190 kgf/cm² if resistance to irregular abrasion is to be improved. Specifically, Ohashi teaches that if the aforementioned dynamic modulus of

elasticity "exceeds 190 kgf/cm², it is inappropriate from the aspect of heat generation, ageing (cracks) or cut resistance." Ohashi, English Translation, page 3, lines 23-25.

Thus, on the basis of Ohashi, one of ordinary skill in the art at the time of the present invention would have been led away from the combination of features defined in independent claims 35, 53, 71, and 85, which require a value of the modulus of elasticity under compression that is higher than the maximum tolerable value taught by Ohashi to achieve useful results.

In the Final Office Action, the Examiner states, with respect to Applicants' previously-presented arguments that Ohashi teaches away from the claimed invention, "The Examiner agrees with applicant's characterization of the reference. However . . . [i]t is suggested that applicant amend the claimed range to require exact value[s] for the lower and/or upper limits [for the modulus of elasticity for the first elastomeric material]." Office Action at 11.

In response, Applicants' have amended independent claims 35, 53, 71, and 85 to omit the word "about" preceding the lower and upper limits for the claimed modulus of elasticity.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of amended independent claims 35, 53, 71, and 85 under 35 U.S.C. § 103(a) as being unpatentable over any combination of Fukuda, Ohashi, Caretta, Matsuo, and Tsubo.

Moreover, claims 36-52, 54-70, 72-84, and 86-95 depend from one of independent claims 35, 53, 71, and 85 and, thus, contain all the elements and recitations thereof. As a result, dependent claims 36-52, 54-70, 72-84, and 86-95 are

allowable at least due to their corresponding dependence from independent claims 35, 53, 71, and 85.

Claim Scope

It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 35-95 in condition for allowance. Applicants submit that the proposed amendments to claims 35, 53, 71, and 85 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were earlier claimed. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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